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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,680	10/09/2001	Jerome James Workman JR.	KCC-16,805	5767

35844 7590 05/18/2005

PAULEY PETERSEN & ERICKSON  
2800 WEST HIGGINS ROAD  
HOFFMAN ESTATES, IL 60195

EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,680

Applicant(s)

WORKMAN ET AL.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 13-24 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 36-38 and 40-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 13-24 and 39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/1/2004.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 36, 40-44 and 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Dow Jr. et al. Dow Jr. et al shows a bandage having a polyethylene or polypropylene backing material with a skin adhering adhesive attached thereto. The examiner notes that Dow Jr. is not for the same purpose as applicant's invention. However, the only difference is intended use and the device is capable of measuring drug transfer. With respect to claims 40 and 41, the bandage of Dow Jr. is textured to resemble human skin. It is the examiner's position that as such, it would meet the criteria of claim 3. With respect to claims 42-44, it is the examiner's position that the adhesives listed in column 2, lines 45-62 include the enumerated adhesives in the claims. As such, the adhesive would have the recited properties. With respect to claims 46, applicant has admitted that it is known to provide packaging materials with an adhesive bandage.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-12, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow jr. et al 5120325. Dow Jr. et al shows a bandage having a polyethylene or polypropylene backing material with a skin adhering adhesive attached thereto. The reference does not specify the weight average molecular weight. However, the examiner notes that applicant has not stated that the specific molecular weight solves a stated problem or is for a particular purpose. As such, it the exact molecular weight would have been a mere matter of design choice for one skilled in the art. The examiner notes that Dow Jr. is not for the same purpose as applicant's invention. However, the only difference is intended use and the device is capable of measuring drug transfer. With respect to claims 3 and 4, the bandage of Dow Jr. is textured to resemble human skin. It is the examiner's position that as such, it would meet the criteria of claim 3. With respect to claims 5-7 , it is the examiner's position that the adhesives listed in column 2, lines 45-62 include the enumerated adhesives in the claims. As such, the adhesive would have the recited properties. With respect to claims 10-12, applicant has admitted that it is known to provide packaging materials with an adhesive bandage and that adhesive bandages come in the sizes and shapes claimed.

Claims 8 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow jr. et al in view of Macphee et al 6762336. Macphee et al teaches the equivalence of adhesive and electrostatic adhesion (see column 4, lines 44-52). Hence, it would

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have been obvious to modify Dow jr. to use electrostatic adhesive, as it is merely the substitution of one known equivalent adhesion for another.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dow jr. et al in view of Cartmell 5160328. Dow jr. et al is silent as to the thickness of the backing layer. Cartmell teaches a bandage like that of Dow jr. where the backing layer has a thickness of 20-100 microns, which overlaps the claimed range. Hence, it would have been obvious to modify Dow Jr. to use the thickness recited in Cartmell, as it is merely the selection of a known bandage size in the art.

Applicant's arguments filed 2/28/2005 have been fully considered but they are not persuasive.

Applicant has asserted that the phrase consisting essentially of defines over Dow Jr. in that the absorbent pad would cause an uneven surface and materially affect the basic characteristics of the claimed invention. The examiner disagrees. The absorbent pad is on the skin side of the bandage of Dow. Applicant's invention is a passive film that lies under a drug transfer device to collect the drug being transferred and then determine the amount of drug transferred thereto. The presence of a thin absorbent pad on the opposite side of the device would not interfere with the drug collection. As such, it would not interfere with the basic operating function of the device, when used as a drug transfer element.

With regard to claims 26-36, they are broader than claims 1-12 as originally filed and applicant provided no argument as to their patentability. Accordingly, those claims are rejected.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

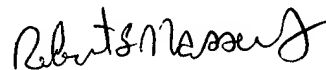
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
May 12, 2005



ROBERT L. NASSER  
PRIMARY EXAMINER